

**Application No.:** 10/591,372  
**Filing Date:** June 25, 2007

## **REMARKS**

Applicant respectfully requests the Examiner to reconsider the above-captioned application in view of the following remarks.

### **Rejections under 35 U.S.C. § 102**

In the Office Action dated October 29, 2010, Claims 1-4, 17, 20, 23-26, 31, 34, 37-39, 41, 45-49, 51, 52, 54, 55, 59-63, 65-68, 71-73, 75, 76, 79, 80, 82 and 86-90 were rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication No. 2005/0164146 by Cantor (hereinafter “Cantor-2005”). Claims 1-4, 17, 20, 23-26, 31, 34, 37-39, 41, 45-49, 51, 52, 54, 55, 59-63, 65-68, 71-73, 75, 76, 79, 80, 82 and 86-90 were rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication No. 2007/0292820 by Cantor (hereinafter “Cantor-2007”).

In a previous response submitted January 29, 2010, Applicant submitted a declaration under 37 C.F.R. 1.131 to establish an actual reduction to practice before the effective filing date of both applications by Cantor. Accordingly, it is respectfully submitted that the rejections over both Cantor references have been overcome.

However, the most recent Office Action deemed the submitted declaration ineffective in overcoming both Cantor references by stating:

“The 131 declaration is ineffective with respect Cantor reference because the reference is a U.S. patent or U.S. patent application publication of a pending or patented application that claims the rejected invention. An affidavit or declaration is inappropriate under 37 CFR 1.131(a) when the reference is claiming the same patentable invention, see MPEP § 2306. If the reference and this application are not commonly owned, the reference can only be overcome by establishing priority of invention through interference proceedings. See MPEP Chapter 2300 for information on initiating interference proceedings.”

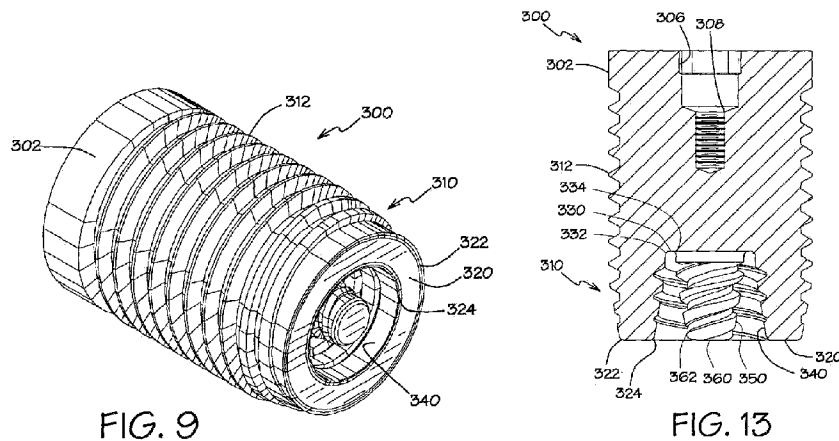
Office Action dated October 29, 2010 at page 3.

Applicant respectfully disagrees and submits that an interference proceeding in this case is inappropriate because the Cantor-2005 reference does not claim the same patentable invention as the present application. “An interference exists if the subject matter of a claim of one party

would, if prior art, have anticipated or rendered obvious the subject matter of a claim of the opposing party *and vice versa*.” 37 C.F.R. 41.203(a) (emphasis added). Furthermore, MPEP 2301.03 states, “If the claimed invention of *either* party is patentably distinct from the claimed invention of the other party, then there is no interference-in-fact.” Citing *Nitz v. Ehrenreich*, 537 F.2d 539, 543, 190 USPQ 413, 416 (CCPA 1976).

Accordingly, for an interference to be proper, the issued claims of the Cantor-2005 reference must anticipate or render obvious the claims of the present application, *and* the claims of the present application must anticipate or render obvious the issued claims of the Cantor-2005 reference. However, Applicant submits that the Cantor-2005 reference has issued claims that are not anticipated nor rendered obvious by the claims of the present application.

For example, allowed (and now issued) independent Claim 1 in the Cantor-2005 reference (now U.S. Patent No. 7,845,945) recites, *inter alia*, “a third inner surface concentric with the external surface and joined to the second annular inner surface along an inner circumference of the second annular inner surface, the third inner surface generally facing away from the longitudinal axis of the dental implant, at least a portion of the third inner surface including a second external thread having the pitch of the external thread; and an apical surface that faces in a generally apical direction and is joined to the third inner surface along an outer circumference of the apical surface.” *See* Figures 9 and 13 of Cantor-2005, reproduced below. The third inner surface and apical surface claimed in Cantor-2005 describe the center protrusion at the apical end of the implant device (reference 350 and 360).



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In fact, in an Office Action for Cantor-2005 dated December 28, 2009, the Examiner stated that then pending Claim 10 contained allowable subject matter, indicating that the subject matter was not anticipated nor made obvious by the prior art. Claim 10 recited the limitation “wherein at least a portion of the third inner surface includes a second external thread having the pitch of the external thread.”

On the other hand, the claims in the present application do not include a center protrusion at the apical end of the implant device. Thus, the claims of the present application do not anticipate the claims of the Cantor-2005 reference. In addition, the claims of the present application do not render obvious the claims of the Cantor-2005 reference as evidenced by the Office Action dated December 28, 2009. Consequently, according to 37 C.F.R. 41.203(a) and further explained in MPEP 2301.03, an interference is inappropriate since the Cantor-2005 reference does not claim the same patentable invention as the present application.

Accordingly, Applicant respectfully submits that the previously submitted declaration under 37 C.F.R. 1.131 is proper and sufficient to overcome the present rejections over the Cantor-2005 and respectfully request that the present application be allowed.

With respect to the rejections over Cantor-2007, Applicant notes that as of the mailing date of this response the claims of Cantor-2007 remain rejected. As noted in the previous response, MPEP 2301.01 states (emphasis added) that:

Example 2

Two applications, C and D, with interfering claims are pending. Examination of application C is completed and all claims are allowable. Examination of application D is not completed. Application C should be issued promptly. If application C has an earlier effective U.S. filing date when issued as patent C, or when published as application publication C, it may be available as prior art under 35 U.S.C. 102(e) against application D. **However, even if application C's effective filing date is later than application D's effective filing date, application C should issue.** Until examination of application D is completed, it is not known whether application D should be in interference with application C, so suspension of application C will rarely, if ever, be justified.

Accordingly, Applicant respectfully submits that the previously submitted 131 declaration is also sufficient to overcome the present rejections over Cantor-2007.

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### **Rejection under 35 U.S.C. § 103**

In the Office Action dated October 29, 2010, Claims 6, 21, 27, 35, 69 and 77 were rejected under 35 U.S.C. 103(a) as being unpatentable over Cantor-2005 or Cantor-2007 in view of U.S. Patent No. 5,591,029 issued to Zuest. Claims 20, 34, 75 and 76 were rejected under 35 U.S.C. 103(a) as being unpatentable over Cantor-2005 or Cantor-2007 in view of U.S. Patent No. 5,816,813 issued to Hansson et al. Claims 22, 36, 43, 44, 53, 57, 58, 78, 84 and 85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cantor-2005 or Cantor-2007.

As discussed above, Applicant respectfully submits that the previously submitted declaration under 37 C.F.R. 1.131 to establish an actual reduction to practice before the effective filing date of both applications by Cantor is proper and sufficient. Accordingly, it is respectfully submitted that the rejections under 35 U.S.C. 103(a) have been overcome.

### ***No Disclaimers or Disavowals***

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, the Applicant is not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. The Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that the Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

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### **CONCLUSION**

Applicant respectfully submits that the above rejections and objections have been overcome and that the present application is now in condition for allowance. Therefore, Applicant respectfully requests that the Examiner indicate that the pending claims are now acceptable and allowed. Accordingly, early issuance of a Notice of Allowance is most earnestly solicited.

Applicant respectfully submits that the claims are in condition for allowance in view of the above remarks. Any remarks in support of patentability of one claim, however, should not be imputed to any other claim, even if similar terminology is used. Additionally, any remarks referring to only a portion of a claim should not be understood to base patentability on that portion; rather, patentability must rest on each claim taken as a whole. Applicant respectfully traverses each of the Examiner's rejections and each of the Examiner's assertions regarding what the prior art shows or teaches, even if not expressly discussed herein. Although amendments have been made, no acquiescence or estoppel is or should be implied thereby. Rather, the amendments are made only to expedite prosecution of the present application, and without prejudice to presentation or assertion, in the future, of claims on the subject matter affected thereby. Applicant also has not presented arguments concerning whether the applied references can be properly combined in view of, among other things, the clearly missing elements noted above, and Applicant reserves the right to later contest whether a proper reason exists to combine these references and to submit indicia of the non-obviousness of the claimed management system.

The undersigned has made a good faith effort to respond to all of the rejections in the case and to place the claim and drawings in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call Applicant's attorney in order to resolve such issue promptly.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

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Respectfully submitted,

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